

Notice of Allowability

Application No.

09/724,744

Examiner

James H. Zurita

Applicant(s)

PIENKOS, JOHN THADDEUS

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to RCE of 02/17/2007.
2. ☒ The allowed claim(s) is/are 59-78.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on 17 February 2007 has been entered.

Response to Amendment

Applicant amended claims 59, 62, 63, 65, 66, 68-71, 73, 75, 76 and 78.

Claims 59, 76 and 78 are independent. Claims 59-78 are allowed.

Examiner's Reasons for Allowance

Updated searches were performed on 13 May 2007. Applicant's comments and amendments are commensurate with the disclosures. The prior art does not specifically disclose, inter alia, the combination of steps of representative claim 59:

The prior art of record is not found to teach or suggest the combination of steps, at a web site, of independent claims 59, 76 and 78, including:

- (a) providing an interface by way of a computer system of an intermediary by which at least one of the first and second parties communicate with the intermediary;
- (b) receiving identification information from at least one of the first and second parties;
- (c) obtaining first information concerning the patent asset...

Art Unit: 3625

- (d) verifying at least one aspect of property rights of the first party in the patent asset;
- (e) performing at least one evaluation...
- (f) negotiating conditions for transfer of at least some of the first party's property rights;
- (g) transferring the at least some of the first party's property rights to the intermediary...
- (h) negotiating conditions for transfer of at least some of the intermediary's property rights; and
- (i) transfer ring the at least some of the intermediary's property rights to the second party ...

Discussion of Closest Prior Art

The closest **US reference** remains previously cited Kossovsky, PG-PUB 2002/0004775A1, published 10 January 2002, filed 20 April 2001 and claiming priority to 17 March 1999. Kossovsky discloses an exchange that auctions rights to patents without obtaining property rights in those patents by the exchange. However, the reference fails to disclose the outright transfer of rights from a first party to an intermediary to a second party found in steps (f) through (i) of the instant application.

The closest **foreign reference** is JP02000268111A, by Kossovsky et al, published in Japan on 29 September 2000 claiming priority to 17 March 1999, which discloses a bidding system among buyers of patents listed on an exchange. Again, Kossovsky does not teach, *inter alia*, outright transfer of rights from a first party to an intermediary to a second party found in steps (f) through (i) of the instant application.

The closest **non-patent literature reference** is Carlson, *Patent pools and the antitrust dilemma*, **Yale Journal on Regulation**. New Haven: Summer 1999. Vol.16, Iss. 2; pg. 359, 47 pgs, which discloses:

Patent pools are private contractual agreements whereby rival patentees transfer their rights into a common holding company for the purpose of jointly licensing their patent portfolios. Pools can comprise as few as two patents, or as many as hundreds. Although

Art Unit: 3625

the contractual provisions governing each pool are tailored to the technologies and patents at hand, patent pools generally share two common characteristics. First, patent pools consolidate the patent rights into a central, independent entity. In many cases, the entity will be a partnership or limited liability corporation.

Carlson does not disclose or reasonably suggest Applicant's claimed features, *inter alia*, specific web-based and other electronic communications functionality recited. In addition, the Examiner notes that the business model described teaches away from the patent pool concept described by Carlson, including characteristics whereby pool companies consolidate patent rights into a central, independent entity that, in many cases, are partnerships or limited liability corporations controlled by the founders.

Conclusion

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee, and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statements for Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Zurita
Primary Examiner
Art Unit 3625
13 May 2007

JAMES ZURITA
PRIMARY EXAMINER

James Zurita